

REMARKS

The amendments to the specification are not new matter for the following reasons:

At line 1 of the original abstract the phrase "comprised of" has been amended to "having" which is a synonym of comprised of, but which is not a term of patent jargon. Since it is a synonym, this is not an insertion of new matter. At line 2 of the original abstract the phrase "Within, Said" is amended to "The" which is a synonym of "said." Since there is only substitution of a synonym that is not patent jargon and the omission of a superfluous word, this is not an injection of new matter. At line 3 of the original abstract "include" is amended to read "includes" merely to improve the English of the abstract. Since only the tense of the verb has been changed and not the meaning, this is not an insertion of new matter. Also at line 3 of the original abstract "plats" has been changed to "plates" also to correct the English of the abstract. This is not an insertion of new matter because page 2, lines 19, 20 of the original specification state "Wherein, the cooling base plate 11 is comprised of two contact plates 111, 111' connected ... " showing that the mention of "plats" is a typographical error. At line 4 of the original abstract "said" is amended to read "the" a synonym for "said" which is not patent jargon. It is not new matter because it is a synonym. At line 6 of the original abstract "said" is amended to read "the" which is a synonym of "said" and therefore is not new matter. At line 8 of the original abstract "connected" is amended to read "connect" which is not new matter since it does not change the meaning of the verb but only changes the tense to improve the English. At line 9 of the original abstract "Said" is amended to read "The" which is a synonym of said and therefore is not new matter. At line 11 of the original abstract "eater" is amended to read "water" to correct a typographical error. It is not new matter because at original claim 1, line 11 "The front of the water pan has a water inlet and a water outlet;" shows that it is a water pan rather than an "eater pan" that has these features in the invention claimed. Also at line 11 of the original abstract "close" has been amended to read "closed" in order to correct the English. This amendment is not new matter because line 18 of the original claim 1 shows "two units of water pans to form a closed pipeline;" and the use of "close" in the abstract is merely a typographical error corrected by the amendment. At line 13 the original abstract is amended so that "said" is changed to "the" so by using a synonym the abstract avoids hyper-technical legal language. It is not new matter

because “said” and “the” are synonyms.

The amendments to the claims are not new matter for the following reasons:

At original claim 1, line 3 “plats” has been amended to read “plates” and this is not an insertion of new matter because page 2, lines 19, 20 of the original specification state “Wherein, the cooling base plate 11 is comprised of two contact plates 111, 111' connected ... “ (showing that the mention of “plats” is a typographical error). The remainder of the amendments to claim 1 of the original application are all amendments to the exact wording but using only lower case letters. This is done to remove the informality of uppercase letters appearing in the claim body. It is not an insertion of new matter because the same words are being used and only the case of the letters is being changed. The amendment to insert new claim 2 is not new matter because the original specification at page 3, lines 3-6 show “ ... by controlling the conduction time, the temperature on one contact plate 111 indicates a comparative lower temperature in relation to that of the other contact plate 111'. Therefore, a temperature difference (ΔT) is created between said contact plates 111, 111'.” The amendment to insert new claim 3 is not new matter because the original application shows at Figure 6 that the cooling exchanger 1 of the present invention is connected to coils 2 and 2'. The original application at page 4, line 9 discloses “heat sinks 3 cladding the coil 2” and page 4, lines 18-20 disclose “The ambient air drawn by the eccentric fan 4 and flowing through the heat sink 3 completes heat exchange to bring down the temperature of the air in the room.” Page 4, lines 3-4 disclose that “ ... both said coils 2, 2' respectively form a closed pipeline with said water pans 12, 12' for water to circulate.” The limitation regarding “controlling a conduction time” is not new matter for the reasons discussed above in relation to claim 2. Therefore all the features and connectivity of claim 3 were disclosed in the original application and it is not new matter. Claim 4 is not new matter for all the reasons discussed above in relation to claim 3 except that claim 4 does not contain the limitation “controlling a conduction time” and even that cannot be new matter since it is an omission rather than an insertion.

35 U.S.C. Section 103 remarks

The burden of proof is on the PTO to establish a prima facie case of obviousness (In Re Warner, 379 F.2d 1011, 154 U.S.P.Q. 173 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968), *rehearing denied*, 390 U.S. 1000 (1968)). The requisite view of the whole invention mandates

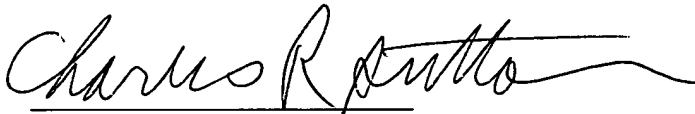
consideration of not only its structure but also its properties and the problem solved (In Re Wright, 848 F.2d 1216, 6 U.S.P.Q.2d 1959, 1962 (Fed. Cir. 1988)). Attey et al. (US 5,544,487) teaches at paragraph 2 of the FIELD OF THE INVENTION that the thermoelectric assembly becomes less efficient as a heat pump when there is an increased temperature difference between the two sides. It states that the result of this is that an electric current must be maintained through the thermoelectric module which is wasteful of energy. This teaches away from the instant invention in which the DC source does not have to be permanent. (See page 3, lines 3-5 of the specification). Therefore the primary reference teaches away from the secondary reference Yokotani et al. (US 5,168,339) where Yokotani seeks to create a large temperature differential (see SUMMARY OF THE INVENTION paragraph 2) for example.

Section 103 does not require that the "person of ordinary skill" be presumed to have full knowledge of prior art outside the field of his endeavor, i.e. of nonanalogous prior art (In Re Antle, 444 F.2d 1168, 170 U.S.P.Q. 285 (C.C.P.A. 1971)). With regard to prior art outside the field of his endeavor, he is only presumed to have knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved (In Re Wood, 599 F.2d 1032, 202 U.S.P.Q. 171 (C.C.P.A. 1979)). The focus of inquiry is on the problem solver and not the user of the solution; i.e., it is the subject matter of the invention and not the field or industry which might thereafter have a use for the invention which must be looked to (Systematic Tool & Mach. Co. v. Walter Kiddle & Co., 555 F.2d 342, 349 (3d Cir. 1977), *cert denied*, 434 U.S. 857, 195 U.S.P.Q. 466 (1977), and May v. American Southwest Waterbed Distribs., Inc., 715 F.2d 876, 219 U.S.P.Q. 862 (5th Cir. 1983), *rehearing denied*, 719 F.2d 404 (5th Cir. 1983), *cert. denied*, 465 U.S. 1103, 224 U.S.P.Q. 736 (1984)). The problem being solved in the instant invention is one of industrial air conditioning. Both Attey et al. (FIELD OF THE INVENTION paragraph 5) and the secondary reference Yokotani et al. (US 5,168,339) (DESCRIPTION OF THE PRIOR ART paragraph 1) teach that the thermoelectric units known to the art are small devices, and necessarily so due to design limitations supposedly affecting the category. The references cited do not try to solve the problem of large scale industrial air conditioning which is the problem being solved by the instant invention. When the alleged prior art does not specifically address the types of problems addressed by the technology of the invention, the prior art alleged is not applicable in combinations to render the invention obvious (Caster v. U.S., 9

U.S.P.Q.2d 1753 (Cls. Ct. 1988)). Where the prior art does not appreciate the existence of the problem solved by the invention, the Applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention (In Re Nomiya, et al., 184 U.S.P.Q. 607, 612-613 (C.C.P.A. 1975)). When the alleged prior art is neither in the same field of endeavor nor pertinent to the problem to be solved there can be no obviousness rejection under 35 U.S.C. §103 (In Re Clay, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992)). The Examiner cannot meet the burden of proving a prima facie case of obviousness here because the references teach away from each other and they do not address the problem being addressed by the Applicant's invention. Therefore the Examiner is respectfully requested to reconsider the rejection of claim 1 under 35 U.S.C. section 103 and to withdraw the same.

WHEREFORE, Applicant respectfully requests the Examiner to enter the amendments and reconsider and withdraw the rejections of the claims as indicated above.

Respectfully submitted,



Charles R. Sutton Reg. No. 42,176

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Charles R. Sutton Reg. No. 42,176

